

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86227093
LAW OFFICE ASSIGNED	LAW OFFICE 116
MARK SECTION	
MARK	<a href="http://tsdr.uspto.gov/img/86227093/large">http://tsdr.uspto.gov/img/86227093/large</a>
LITERAL ELEMENT	DRX
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<p>In response to the Official Action of December 22, 2014, Applicant respectfully requests that the Examiner reconsider her position and withdraw the refusal under Trademark Act Section 2(d). In support of her refusal, the Examiner cites existing Registration Nos. 3883054 for DRX ROMANELLI. It is respectfully submitted that as set forth herein, this registration does not present a bar to registration of the Applicant's mark.</p> <p>There is no likelihood of confusion between the cited mark, on the one hand, and the Applicant's mark, on the other hand because of the differences in the sound, appearance, meaning and/or applicable goods and as such the overall commercial impressions of the respective marks. One is immediately struck by the obvious differences in the terms themselves. Registration no. 3883054 includes the term ROMANELLI which the Applicant's mark does not. It is axiomatic that in determining whether a likelihood of confusion exists, the Examiner may not dissect the marks, but must consider the marks in their entireties. <u>Estate of P.D. Beckwith, Inc. v. Commissioner of Patents</u>, 252 U.S. 538, 545-46 (1920). The addition of the 4 syllable term ROMANELLI, which is a common Italian surname, gives Reg. No. 3883054 a different appearance and sound. ROMANELLI includes the term Roman and gives the cited mark an association with Italy or with an Italian family. DRX alone has no such meanings, associations or connotations.</p> <p>Furthermore, the cited mark and the name ROMANELLI are associated with the well known designer, marketer and director Darren Romanelli. A prinout of a wikipedia entry for Mr. Romanelli is attached hereto as Exhibit A. The existence of the wikipedia entry is evidence of Mr. Romanelli's renown and</p>	

makes it highly unlikely anyone would confuse Mr. Romanelli's DRX ROMANELLI mark, viewed in its entirety, with the Applicant's mark.

Applicable legal precedent holds that one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); In re J.M. Originals Inc., 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii). In this case the ROMANELLI term is the dominant part of the mark and significant in creating a distinct commercial impression. In such a case registration is proper. Shen Manufacturing Co. v. Ritz Hotel, Ltd., 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004); In re Farm Fresh Catfish Co., 231 USPQ 4995 (TTAB 1986); In re Shawnee Milling Co., 225 USPQ 747 (TTAB 1985).

Further, the DRX ROMANELLI mark pertains only to clothing, whereas the Applicant's mark pertains only to athletic footwear and footwear. If the respective goods under the marks are not related or marketed in such way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is no likely. Shen Manufacturing Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004). Here the respective products, clothing, on the one hand, and Applicant's athletic footwear, on the other hand, would be marketed and sold in distinct channels of trade so that consumer confusion is unlikely.

Based upon the foregoing, further action on this application is respectfully solicited.

## EVIDENCE SECTION

### EVIDENCE FILE NAME(S)

#### ORIGINAL PDF FILE

[evi\\_381400114-20150622141245997803\\_.\\_drx.evidence.pdf](#)

#### CONVERTED PDF FILE(S) (8 pages)

[\\TICRS\EXPORT16\IMAGEOUT16\862\270\86227093\xml7\RFR0002.JPG](#)

[\\TICRS\EXPORT16\IMAGEOUT16\862\270\86227093\xml7\RFR0003.JPG](#)

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#### DESCRIPTION OF EVIDENCE FILE

a Wikipedia printout

## SIGNATURE SECTION

#### RESPONSE SIGNATURE

/peter j. vranum/

<b>SIGNATORY'S NAME</b>	Peter J. Vranum
<b>SIGNATORY'S POSITION</b>	Attorney of record, New York bar member
<b>SIGNATORY'S PHONE NUMBER</b>	212-986-1200
<b>DATE SIGNED</b>	06/22/2015
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Mon Jun 22 14:15:09 EDT 2015
<b>TEAS STAMP</b>	USPTO/RFR-38.140.0.114-20 150622141509675325-862270 93-530a9804a1a4348de9d953 d4579384e5d12ff423686b49c ea5d3864f456bcdd63f-N/A-N /A-20150622141245997803

## Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **86227093** DRX(Standard Characters, see <http://tsdr.uspto.gov/img/86227093/large>) has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

In response to the Official Action of December 22, 2014, Applicant respectfully requests that the Examiner reconsider her position and withdraw the refusal under Trademark Act Section 2(d). In support of her refusal, the Examiner cites existing Registration Nos. 3883054 for DRX ROMANELLI. It is respectfully submitted that as set forth herein, this registration does not present a bar to registration of the Applicant's mark.

There is no likelihood of confusion between the cited mark, on the one hand, and the Applicant's mark, on the other hand because of the differences in the sound, appearance, meaning and/or applicable goods and as such the overall commercial impressions of the respective marks. One is immediately struck by the obvious differences in the terms themselves. Registration no. 3883054 includes the term ROMANELLI

which the Applicant's mark does not. It is axiomatic that in determining whether a likelihood of confusion exists, the Examiner may not dissect the marks, but must consider the marks in their entirety. Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538, 545-46 (1920). The addition of the 4 syllable term ROMANELLI, which is a common Italian surname, gives Reg. No. 3883054 a different appearance and sound. ROMANELLI includes the term Roman and gives the cited mark an association with Italy or with an Italian family. DRX alone has no such meanings, associations or connotations.

Furthermore, the cited mark and the name ROMANELLI are associated with the well known designer, marketer and director Darren Romanelli. A printout of a wikipedia entry for Mr. Romanelli is attached hereto as Exhibit A. The existence of the wikipedia entry is evidence of Mr. Romanelli's renown and makes it highly unlikely anyone would confuse Mr. Romanelli's DRX ROMANELLI mark, viewed in its entirety, with the Applicant's mark.

Applicable legal precedent holds that one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); In re J.M. Originals Inc., 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii). In this case the ROMANELLI term is the dominant part of the mark and significant in creating a distinct commercial impression. In such a case registration is proper. Shen Manufacturing Co. v. Ritz Hotel, Ltd., 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004); In re Farm Fresh Catfish Co., 231 USPQ 4995 (TTAB 1986); In re Shawnee Milling Co., 225 USPQ 747 (TTAB 1985).

Further, the DRX ROMANELLI mark pertains only to clothing, whereas the Applicant's mark pertains only to athletic footwear and footwear. If the respective goods under the marks are not related or marketed in such way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is no likely. Shen Manufacturing Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004). Here the respective products, clothing, on the one hand, and Applicant's athletic footwear, on the other hand, would be marketed and sold in distinct channels of trade so that consumer confusion is unlikely.

Based upon the foregoing, further action on this application is respectfully solicited.

## **EVIDENCE**

Evidence in the nature of a Wikipedia printout has been attached.

### **Original PDF file:**

[evi\\_381400114-20150622141245997803\\_.drx.evidence.pdf](#)

### **Converted PDF file(s) ( 8 pages)**

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /peter j. vranum/ Date: 06/22/2015

Signatory's Name: Peter J. Vranum

Signatory's Position: Attorney of record, New York bar member

Signatory's Phone Number: 212-986-1200

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86227093

Internet Transmission Date: Mon Jun 22 14:15:09 EDT 2015

TEAS Stamp: USPTO/RFR-38.140.0.114-20150622141509675

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## **EXHIBIT A**

# Darren Romanelli

From Wikipedia, the free encyclopedia

**Darren Romanelli** (DRx, Dr. Romanelli) is a Los Angeles based designer, marketer, and director.<sup>[1]</sup> He is most notable for creating series of customized, limited edition clothing, furniture and collectibles. Romanelli adds his signature (DRx) to each project and has been involved with all levels of a project's development, from inception to display to promotion.<sup>[2]</sup> He has had collaborations with Converse,<sup>[3]</sup> Coca-Cola,<sup>[4]</sup> Jaeger LeCoultre,<sup>[5]</sup> and Disney among others.<sup>[6]</sup>

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## Darren Romanelli



Darren Romanelli, 2013

<b>Nationality</b>	American
<b>Other names</b>	Dr. Romanelli, DRx
<b>Occupation</b>	Designer · Marketer · Director
<b>Website</b>	
	<a href="http://www.drromanelli.com">www.drromanelli.com</a>
	( <a href="http://www.drromanelli.com/">http://www.drromanelli.com/</a> )

## Collaborations

### 2014

**DRx x British Knights** - British Knights is a New York-based footwear label inspired by hip-hop culture. Romanelli was brought on board as the creative "doctor" to bring a new look to the non-performance shoes. In this collaboration he created four styles that combined performance-level materials with streetwear aesthetics. Features included earth tone midtops with ribbed brown leather paneling and black and white hi-tops that incorporate the British flag. The first designs were unveiled on February 17, 2014 at Agenda (<http://agendashow.com/travel/las-vegas>) in Las Vegas before officially going on sale March 15, 2014.<sup>[7][8]</sup>

### 2013

- **DRx x Coca-Cola** - Romanelli – inspired by his own collection of retro Coke clothing, hand-picked from flea markets and vintage stores in his hometown of Los Angeles to launch this 200 piece Coca-Cola by DRx collection, replete with his signature bomber and biker jackets, vests, and cut-and-sew t-shirts. The collection also included Coke workwear uniforms of deliveryman jackets and factory-worker button-ups that still had the

employee's names stitched on the garments. The collection was available at select retailers, including Opening Ceremony in New York ([http://wikifashion.com/wiki/Opening\\_Ceremony](http://wikifashion.com/wiki/Opening_Ceremony)), Juice in Hong Kong,<sup>[9]</sup> Fruition in Las Vegas,<sup>[10]</sup> Colette in Paris and United Arrows<sup>[11]</sup> in Tokyo.

- **DRx x Converse Boro Chuck Taylor 1970s** - Romanelli has worked with Converse before and for this collaboration decided to use vintage boro, a collectible Japanese textile. The Converse Chuck Taylor 1970s encapsulated both brands' (Romanelli's and Converse's) appreciation for premium materials with olive cotton twill, inspired by a vintage World War II U.S. Army jacket from Romanelli's personal vintage collection, paired with a coarse cotton plaid. Due to the nature of these materials each pair made was slightly different and sold in limited supply.<sup>[12][13]</sup>
- **DRx x Stussy Taipei Capsule Collection** - Developed over the course of more than a year, Romanelli collaborated with Stussy for their Taipei Capsule Collection in honor of the Stussy Taipei's store opening. Visiting Stussy's warehouses, Romanelli sifted through vintage collections for the most iconic pieces from Stussy's past. He then fused these items together to formulate new pieces, with some of the elements dating as far back as the 1980s. The result was an amalgamation of Stussy's history, a collection that was to both celebrate the brand's past and acknowledges its transition into the future. The collection was available exclusively at the Stussy Taipei chapter store.<sup>[14]</sup>



DRx x Coca-Cola Collaboration, 2013

## 2012

- **DRx for Disney Couture Jewelry Collection** - In this collaboration with Disney Couture, Romanelli created a limited-time collection that reconstructed Disney characters from junkyard materials, while still keeping their iconic designs. The collection boasted unique reconstruction to ensure each piece of jewelry was truly different.<sup>[15]</sup>
- **Stealth by DRx For UNKNWN LeBron James Jersey Collection** - For the UNKNWN Stealth Collection Romanelli used a selection of skins, leathers and vintage military materials to create the reconstructed jerseys. The collection was sold in limited supply at the menswear shop, UNKNWN owned by LeBron James in Miami, FL.<sup>[16][17]</sup>

## 2011

- **DRx and Medicom - BearBricks Toy - Popeye Vs. Beetle Bailey** - As part of one of his holiday collections, Army Vs. Navy, Romanelli collaborated with Medicom Toy to include a collection of BearBricks Toys incorporating the likeness of Popeye and the popular Beetle Bailey comic strip character. One of the toys represented the 'Navy' side with Popeye and the other represented the 'Army' side with Beetle Bailey. The toys were sold at select Medicom retailers and were featured in both 100% and 400% versions.<sup>[18][19]</sup>
- **Dr. Romanelli - Beetle Bailey vs. Popeye - Converse Chuck Taylor All Star Hi Shoe** - Following up on the Dr. Romanelli and Medicom Bearbricks Toy: Beetle Bailey and Popeye collaboration<sup>[20]</sup> Romanelli again joined forces with Converse to add shoes to the Beetle Bailey Vs Popeye Collection, which launched exclusively at Bloomingdales on October 15, 2011. Together with Converse, Romanelli presented two Chuck Taylor All Star Hi shoes. One of them featured a military green canvas upper, black leather details, gum sole with rubber toe cap, numerous embroidery and a Beetle Bailey comic strip print lining. The second one came with a black wool upper, anchor embroidery, red line detail on the ankle and a Popeye comic strip print lining.<sup>[21]</sup>

## 2010



- **The Chuck Taylor *All Star and Stripes*, Shoe** - Romanelli was the first artist to collaborate with Converse when the Chuck Taylor All Star shoes were first introduced. The *All Star and Stripes* shoe, with the All Star silhouette and futuristic touches, debuted in June 2010. The shoes were a combination of classic Converse style and modern details as Romanelli regularly fuses vintage Americana while using a modern approach. Romanelli added stars and stripes to two versions of the shoe and both versions incorporated clean uppers with 12-ounce duck canvas and leather with antiqued details that together make up the stripes of the American flag. Wool toe caps lent the feeling of a vintage peacoat and gum soles added to the classic look and feel of the shoe. In addition, Romanelli's abbreviated "Dr. X" moniker appeared on the tongue and a unique rendition of the American eagle could be found on the sock liner. The shoe was available in high-top leather and duck canvas with wool toe caps and gum soles.<sup>[22]</sup>
- **Converse - (PRODUCT) Red - Chuck Taylor Pack, Shoe** - Converse teamed up with Romanelli and AIDS awareness group PRODUCT (RED) on a special duo of Chuck Taylor's. Romanelli kept the All Star 2000s look while adding two color ways of American flag-inspired Chucks. The shoe also featured duck canvas, pea-coat wool, and a gum sole to make the shoes. These shoes were a limited edition and proceeds supported the PRODUCT (RED) cause.<sup>[23][24]</sup>

## 2009

- **Fraggle Rock - Dr. Doozer** - A line of high-fashion t-shirts and toys designed by Romanelli featuring Jim Henson's Fraggle Rock characters. The line was sold at high-end stores such as; Kitson in West Hollywood and Colette in Paris.<sup>[25]</sup>
- **Pete Wentz - Fall Out Toyworks** - Fall Out Toy Works is a limited edition comic book series, created by Romanelli, Pete Wentz of Fall Out Boy and Nathan Cabrera. It was written by Brett Lewis, whose previous work includes *The Winter Men*, and was illustrated by several members of Imaginary Friends Studios. The first issue was published by Image Comics on September 2, 2009. The story is about androids with artificial intelligence in a futuristic Los Angeles. It has been compared to *Pinocchio* and *Pygmalion*.<sup>[26]</sup>

## 2008

- **DRx and Huf**- Romanelli collaborated with Huf, an independent manufacturer of premium apparel, footwear, and skateboarding goods located in both Los Angeles and San Francisco, to create a collection of jackets, handmade winter boots, fur caps, down vests, skateboard decks and t-shirts. All pieces reflected an outdoors/hunting theme and were sold exclusively at Huf in Los Angeles and Huf in San Francisco.<sup>[27]</sup>

## 2007

- **Looney Tunes - What's Up DRx**- "What's Up DRX" depicted the Warner Bros. Looney Tunes characters as mad scientists for a clothing line and limited edition toy designed by Romanelli.<sup>[28]</sup>
- **DRx - Surgical Strike Installation - Maharishi, London** - (2007) - Romanelli and painter Andrew Brandou collaborated on an installation for London retailer, Maharishi. Working together in a military theme, Romanelli and Brandou each created a body of work incorporating the culture of war from different angles. Inspired by his love of vintage military garments, Romanelli took a wide range of iconic uniform pieces from several countries and reimagined them as high-end luxury apparel far removed from their original utilitarian purposes. Brandou created a new series of works reinvisioning the world of legendary wildlife artist John James Audubon as populated by a new breed of fashion-conscious and heavily armed animals. The pieces created by Romanelli in this collection told a story that mixed with the artwork of Brandou's exhibition.<sup>[29][30][31]</sup>

## 2006

- **Jaeger LeCoultre - Reverso Romanelli**- Romanelli designed a limited edition watch for the luxury watch brand accompanied by a black and white leather jacket which integrated a wrist attachment for the watch.<sup>[32]</sup>

- **"Black Sabbath Resurrection"**- A limited edition line of accessories inspired by the heavy metal band Black Sabbath. The "Black Sabbath Resurrection" collection was created by Black Sabbath in collaboration with Romanelli and in partnership with Signatures Network. Romanelli wanted to pay tribute to, "one of the most iconic rock bands of all time," and also create products that capture the authenticity and impact of the band that would attract both a new generation and long-time fans.<sup>[33][34]</sup>

## 2004

- **Nike - RECONSTRUCT Project** - In 2004 Nike approached various designers throughout Los Angeles and gave them 24 hours to work with a box of Nike scraps off the cutting room floor. Romanelli's creations for RECONSTRUCT inspired a DR. Romanelli / Nike collaboration, creating intricate patchwork jackets from vintage Nike jumpers. This Nike / DR. Romanelli collaboration is ongoing.<sup>[35][36]</sup>

## 1999

- **Sophnet - F.C.R.B Collection**- The F.C.R.B collection for Sophnet, an Asian retailer, is reconstructed cut and sewn t-shirts, polos, and jackets designed by Romanelli. This collaboration has been ongoing and can only be found at the retailer in Japan.<sup>[37][38]</sup>

## Marketer

**StreetVirus** is a marketing agency in which Romanelli is co-owner. The agencies client roster has included; Disney, FOX, Warner Bros., Converse, and Grenco Science the makers of the G Pen.<sup>[39]</sup> Romanelli and StreetVirus have aligned brands with specialty boutiques in cities around the world such as; Maxfield Department Store in Los Angeles, Colette in Paris, and Barneys in Tokyo.<sup>[40]</sup>

**The Pancake Epidemic**, a division of StreetVirus, is a creative agency which focuses strictly on content creation. The offices are located directly above the iconic IHOP in the Miracle Mile district of Los Angeles and officially opened its doors in September, 2012.<sup>[41]</sup>



The Pancake Epidemic, Est. 2012

**Blank You Very Much** is an online crowd-sourcing design platform that consists of nearly 50,000 graphic designers from around the world. Curated by Romanelli and StreetVirus, BYVM offers global brands the opportunity to engage their audience through the lens of art and design. BYVM launched in 2012 and has worked with iconic sport and lifestyle brands including, Coca-Cola, Burton Snowboards, HUF (<http://www.hufworldwide.com/>), and SOBE, among others.<sup>[42]</sup>

## Director

In 2011, Romanelli directed, "Dawned On Me", a music video from American alternative rock band Wilco. The song came off their Grammy nominated album, "The Whole Love", which was released in September 2011. This was the first video for the band since 1999. Romanelli conceived the idea of the video - a black-and-white vintage cartoon which features Popeye and the likeness of Wilco frontman, Jeff Tweedy, along with the rest of the band. The video debuted in January 2012 and this collaboration with King Features whom syndicates the comic strip, presents the first hand-drawn Popeye cartoon in more than 30 years.<sup>[43]</sup>

In 2012, Romanelli was called on to direct another music video, this time for Los Angeles based singer, Ryan McDermott whom at the time had recently signed to Kanye West's G.O.O.D Music. The video was for McDermott's first single, "Paradise", and came off his album, "Ryan vs. The Sandman."

In 2013, Romanelli directed a music video for hip-hop artist Kendrick Lamar featuring artist Eddie Peake. The video was a two-part series for Lamar's song, "Sing About Me (Part 1)" off his album, *Good Kid, M.A.A.D City*. Part one was released in December and Romanelli conceptualized the idea between Lamar and Peake, two artists coming together to, "lay ground to their legacy".<sup>[44]</sup> The video starts with Kendrick driving around his hometown, Compton. From there, the scene shifts to a warehouse where Peake begins to work on a spraypainting piece to correspond with the song and ends with Lamar entering the warehouse to look at the painting. Satisfied with what he sees, he turns and walks away.<sup>[45]</sup> Though a simple premise, Romanelli's goal was to reinforce the 'stream-of-consciousness' style of the song itself.<sup>[46]</sup>

## References

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2. Double Dose of Cool: Darren Romanelli Has the Prescription For Lupe Fiasco (<http://articles.latimes.com/2007/dec/lupe23>), LA Times, December 2007, Retrieved 8 November 2012
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12. Dr. Romanelli Converse Boro Chuck Taylor 1970s, HighSnobiety.com, July 2013, Retrieved Feb. 2014 (<http://www.highsnobiety.com/2013/romanelli-converse-boro-chuck-taylor-1970s/>)
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## External links

- Dr. Romanelli Official Website (<http://www.drromanelli.com>)
- Dr. Romanelli Official Blog (<http://drromanelli.com/blog>)
- StreetVirus Official Website (<http://www.StreetVirus.com>)

- The Pancake Epidemic Official Website (<http://thepancakeepidemic.com/>)

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